

REMARKS

Reconsideration of the rejections set forth in the Office Action dated November 5, 2008, is respectfully requested. In the Office Action, the Examiner rejected claims 177-201. Applicant has amended claims 177, 187, and 188. Accordingly, claims 177-201 are pending in the application, and no new matter has been added as can be confirmed by the Examiner.

A. Claim Amendment Not Made for Substantial Reasons Related to Patentability

Applicant has amended claim 188 merely to correct a typographical error only. Therefore, the claim amendment has not been made for substantial reasons related to patentability.

B. The Cited Prior Art References Do Not Disclose Or Suggest Automatedly Searching One Or More Portions Of The Target File For The Occurrence Of One Or More First Source Elements In Accordance With Said Key As Recited In Amended Claims 177-201.

In the Office Action, the Examiner rejected claims 177-201 as being allegedly rendered obvious under 35 U.S.C. § 103(a) by Rabin et al. alone or in view of Stratigos et al., United States Patent No. 5,537,486, or in further view of Agrawal et al., United States Patent No. 5,647,058. Applicants respectfully submit, however that, by failing to disclose each and every element of new independent claims 177 and 187, Rabin et al. neither anticipates nor renders obvious independent claims 177 and 187. Therefore, it is submitted that independent claims 177 and 187, as well as claims 178-186 and 189-201 that depend thereon, are in condition for allowance.

Rabin et al. disclose an automated vendor tag system for software products, wherein the vendor tag system interacts with a monitoring program on a user device to inhibit unauthorized use. According to the Examiner, Rabin et al. at col. 21, lines 3-8 teach that "[a] verification program, resident on the guardian center, compares each fingerprint received from the user device against the fingerprints in its fingerprint data structure to determine if an untagged instance of software used on a user device is an infringing instance of software." See November 5, 2008, Office Action at page 3. Moreover, so the comparison can be accomplished, Rabin et al. teach, "In this system, the supervising program detects the use of the untagged instance of software and performs a fingerprinting

process on the untagged instance of software[.]” See Rabin et al., col. 6, lines 55-58. In currently amended claims 177 and 187, the target file does not require performance of a fingerprinting process. Further, the Examiner does not assert that Rabin et al. teach automatedly searching one or more portions of the target file for the occurrence of one or more first source elements in accordance with said key as set forth in currently amended claims 177 and 187.

At least one recited element of independent claims 177 and 187 therefore is totally missing from Rabin et al. In accordance with M.P.E.P. § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). The disclosure of a claim element in a prior art reference, when relied upon to negate patentability, must also be clear and unambiguous. Further, “[t]he identical invention must be shown in as complete detail as contained in the...claim.” *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, and uniquely important in this case is the requirement that the elements relied on in the prior art reference must be arranged as required by the claim. See *In re Bonds*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Accordingly, Applicants submit that Rabin et al. fails to disclose each and every element of independent claims 177 and 187. Claims 177-201 therefore are not anticipated by Rabin et al. and are in condition for allowance.

C. No Motivation Exists to Modify the Teachings of the Cited Prior Art References in a Manner that Precludes the Patentability of Claims 177-201 Under 35 U.S.C. § 103(a).

In addition to the reasons stated above, there is no teaching or motivation in the prior art to modify the teaches of Rabin et al., Stratigos et al., or Agrawal et al. in a manner that renders claims 177-201 obvious under 35 U.S.C. § 103(a).

In accordance with M.P.E.P. § 2142, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met.” (M.P.E.P. § 2143.) First, some suggestion or motivation in the prior art references or in the knowledge of one of

ordinary skill in the relevant art must exist to modify or combine the references. Second, if the references are combined, a reasonable expectation of success must be shown. Then, finally, all of the claim limitations must be taught or suggested by one reference or a combination of references. To establish a *prima facie* case of obviousness based on a single reference that does not teach all the elements of a claim, the Examiner must provide a rationale for modifying the teachings of the reference. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), citing, *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

In the manner discussed in more detail above, at least one recited element of claims 177-201 is totally missing from Rabin et al. Further, the Examiner does not assert that any teaching or motivation exists in the prior art to modify Rabin et al. in a manner that renders claims 177-201 obvious. The Examiner does not rely on the teaching of Stratigos et al. or Agrawal et al. to supplement the disclosure of Rabin et al. The Examiner therefore has not established a *prima facie* case under 35 U.S.C. § 103 because, as shown above, all of the elements of the pending claims are not found in the cited prior art references. According, Applicants respectfully submit that claims 177-201 are not rendered obvious by Rabin et al., either alone or in combination with Stratigos et al., or Agrawal et al., and therefore are in condition for allowance.

For at least the reasons set forth above, it is submitted that claims 177-201 are in condition for allowance. A Notice of Allowance is earnestly solicited. The Examiner is encouraged to contact the undersigned at (408) 341-2345 if there is any way to expedite the prosecution of the present application.

Respectfully submitted,

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Dated: May 5, 2009

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